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SUPREME COURT, U. S.

IN THE

Supreme Court of the United States

October Term, 1973

No. 73 1202

KERMIT H. WILSON and
SICO INCORPORATED,

Petitioners,

vs.

MIDWEST FOLDING PRODUCTS
MANUFACTURING CORP.
and
MIDWEST FOLDING PRODUCTS
SALES CORPORATION,

Defendants.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

JOHN D. GOULD
ROBERT T. EDELL
MERCHANT, GOULD,
SMITH & EDELL
Professional Association
1630 Midwest Plaza Building
Minneapolis, Minnesota 55402
Attorneys for Petitioners
Kermit H. Wilson and
Sico Incorporated

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TABLE OF CONTENTS

	PAGE
Citations to Opinions Below	2
Jurisdiction	2
Questions Presented	2
Constitutional Provision and Statutes Involved	3
Statement of the Case	3
Reasons for Granting the Writ	6
I. The Decision Below Raises Significant and Recurring Problems Concerning Application of the Criteria of *Graham v. John Deere* in the Trial of Patent Cases	6
II. A Second Significant Problem Not Resolved by the Decision of the Seventh Circuit Is the Disposition of Patent Cases on Appellate Review	8
Conclusions	11

TABLE OF AUTHORITIES

	PAGE
Cases:	
Blonder-Tongue Labs v. University Foundation, 402 U.S. 313, 335 (1971)	9
Graham v. John Deere, 383 U.S. 1 (1966)	2, 3, 6, 8, 10, 11
L & A Products, Inc. et al. v. Britt Tech Corp., 365 F.2d 83 (8th Cir. 1966)	9
Novo Indus. Corp. v. Standard Screw Co., 374 F.2d 824 (7th Cir. 1967) cert. denied 389 U.S. 823 (1967)	9
Constitutional Provision:	
Article I, §8, Clause 8	3
Statutes and Rules:	
28 USC §1254(1)	2
35 USC §103	3, 7
35 USC §282	3, 6, 7
Federal Rules of Civil Procedure, Rule 52(a)	9

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

The Petitioners respectfully request that this Court grant a Writ of Certiorari to review the decision of the United States Court of Appeals for the Seventh Circuit entered in this case on November 7, 1973 in Appeal No. 72-2031, affirming the judgment of the District Court that Claims 1, 6, 7, 8 and 9 of United States Patent No. 3,055,705 are invalid and, if those claims are valid, Defendants accused devices do not infringe them.

CITATIONS TO OPINIONS BELOW

The opinion of the Court of Appeals, dated November 7, 1973 is presently unreported and printed herein at A-1.[1] The opinion of the District Court for the Northern District of Illinois, Eastern Division, is unofficially reported at 175 USPQ 649 and printed at A-2.

JURISDICTION

The judgment of the Court of Appeals was entered November 7, 1973; and this Petition was filed within ninety days of that date. The jurisdiction of this Court is invoked under 28 USC §1254 (1).

QUESTIONS PRESENTED

1. Did the lower courts, failing to follow *Graham vs. John Deere*, err in holding a patent invalid under 35 USC §103:
   (a) without any evidence of the "level of skill in the art" and without resolution of the level of skill by the trial court;
   (b) without determining the difference between the prior art and the claims at issue; and
   (c) when Defendants' evidence consisted of prior art patents, the primary reference having been before the Patent Office, and only counsel's argument of obviousness without actual evidence of obviousness?
2. Did the lower courts err by not giving the same interpretation to the claims on the issue of infringement as on the issue of validity?

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[1] The abbreviation "A" herein is used to refer to the Appendix bound with this Petition.

3. If the trial court erred, what disposition of the case should be made on appellate review?

CONSTITUTIONAL PROVISION AND STATUTES INVOLVED

The Constitutional provision involved is Article I, §8, clause 8.

The Statutes involved are 35 USC §103 and the first sentence of 35 USC §282.

STATEMENT OF THE CASE

Petitioners seek to revive the presumption of the validity of a patent, 35 USC §282, by requiring a Court to determine validity on evidence, within the guidelines of *Graham v. John Deere;* [2] and not on its own opinion of what should constitute a patentable invention.

Petitioners also seek to have appellate review of patent cases brought into conformity with other types of cases. The fundamental purpose of appellate review is to determine if the trial court erred.

The invention of the patent in suit consists of a folding table with attached individual seats, all parts of which can be easily folded by one person between a horizontal operative position and an upright, compactly folded, mobile, storage position. The table is used in school cafeterias and for similar institutional purposes. Indeed, the invention was the first known institutional-type table with attached individual chairs or stools which folds as a unit. This invention provides for multiple seating at a table which can be quickly and easily set up and

[2] Graham v. John Deere Co., 383 U.S. 1 (1966).

removed by one person to permit multiple use of space. At the same time, the invention provides for controlled individual seating with ease of access. A further advantage of the invention not shown by the prior art is its modular construction permitting the commercial designs of Plaintiffs and Defendants to be manufactured in models of 8, 12 and 16 individual seats per table.

Prior to the time of the alleged invention, there were in use folding tables with attached benches which permitted multiple use of space; but incident to this advantage were seating problems obviated by the invention in suit. Certain of these problems were crowding at the table or selfishly taking more space than needed; pushing and shoving along the benches; hazard in getting into and out of the bench; and a lack of controlled seating.

The problems of the prior art bench-type tables existed for a long period of time until the advent of the invention in suit. Plaintiffs' tables have been commercially successful and served a recognized need.

The utility of the invention is not at issue. Upon the merits, Plaintiffs shall show novelty and "non-obviousness" of the invention. More important, Plaintiffs shall show that Defendants' proof failed to overcome the presumption of validity.

The best prior art relied on by Defendants on the issue of validity was before the Patent Office; and Defendants offered no expert testimony with respect to the prior art. Defendants offered no evidence on the level of skill in the art. Defendants offered no evidence tying the level of skill in the art to the difference in the invention over the prior art.

Defendants, through their attorney, introduced certain individual prior art patents to the trial court. Neither of Defendants' two witnesses explained how the structures of each

patent operated, nor did they compare the claims of the patent in suit with the prior art patents to provide evidence for the court to determine the "differences" between the invention in suit and the prior art. The sum total of Defendants' evidence on the prior art, in addition to the documents themselves, was the introduction of a hybrid exhibit, DX 55, allegedly made according to the Mackintosh prior art patent, the primary reference relied on by the Patent Examiner in the Patent Office. To the extent that this exhibit was not made in accordance with Mackintosh, it should have been inadmissible for lack of foundation; and to the extent that it represented the disclosure of Mackintosh, it added nothing to the prior art patent. Thus, it is a fair characterization of Defendants' entire proof that it consisted merely of prior art patents, the primary of which was before the Patent Office during the prosecution of the application of the patent in suit, and an argument by counsel of "obviousness".

In support of the invention, Plaintiffs introduced evidence of the problems with the prior art bench-type tables; of the advantages of and need for the invention; of commercial success and recognition that the invention was a contribution to its art. Plaintiffs' expert witness testified the invention was not obvious.

Plaintiff Sico is a relatively small company,[3] but it has made a name for itself not only in the United States but elsewhere throughout the world in a small market by innovating quality products meeting specialized needs in schools, churches hotel and motels. Patents have been important to Sico to protect its creative research and development, to provide incentive to create new and useful products, and to provide

[3] Approximately 130 employees and $6,000,000 in sales.

a means to market, through patent license agreements, its technology and innovations outside of the United States.

In addition to the very real individual problem which the District Court's decision has created for Plaintiffs, erroneously affirmed by the Seventh Circuit, the bases of the lower courts' decisions raise significant and recurring problems concerning the application of *Graham v. John Deere, supra,* and the trial and appellate review of patent cases.

REASONS FOR GRANTING THE WRIT

I. The Decision Below Raises Significant and Recurring Problems Concerning Application of the Criteria of *Graham v. John Deere* in the Trial of Patent Cases.

A patent is presumed to be valid, 35 USC §282.

Assuming novelty and utility, patentability is to depend upon the "non-obviousness" nature of the "subject matter sought to be patented" to a person having ordinary skill in the pertinent art. Conversely, to overcome the presumption of validity, there must be evidence before the Court to support the conclusion that the "subject matter sought to be patented" was "obvious" to a person having ordinary skill in the pertinent art.

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere, supra,* at 17.

How does a Court resolve the level of ordinary skill in the pertinent art when a defendant fails to introduce any evidence

on such level? A significant question to be determined by this Court is whether the presumption of validity can be ignored and a patent held invalid under 35 USC §103 without any evidence of the "level of skill in the art" and without resolution of such level by the trial court.

How does a trial court properly determine the obviousness of an invention when a defendant fails to introduce evidence on the difference between the prior art and the claims at issue? A significant question to be determined by this Court is whether the presumption of validity can be ignored and a patent held invalid under 35 USC §103 when a defendant merely introduces the prior art patents and his attorney argues "obviousness".

How does a trial court properly determine the obviousness of an invention when a defendant fails to introduce evidence tying the level of skill in the art to the difference between the invention and the prior art and providing a factual basis for a court's conclusion of obviousness?

This Court has set forth the criteria for determining obviousness under 35 USC §103. To overcome the presumption of validity provided by 35 USC §282, a defendant must introduce the evidence from which the trial court can make the inquiry required by *Graham v. John Deere, supra.* If the evidence is insufficient, the presumption must stand. If the evidence is sufficient, but the trial court either fails to or erroneously makes the inquiry required by *Graham,*[4] the case should be remanded for a new trial or for proper application of the law to the evidence.

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[4] Although such may have been necessary to give specific application of the criteria of *Graham* and it may have hazarded a different ultimate conclusion, it is respectfully suggested that if this Court had remanded *Graham* and *Adams* instead of substituting its opinion of "obviousness" for a lower court's opinion, appellate review of patent cases would be further advanced. See Reason II infra.

If this case is not reviewed and the lower courts' decisions corrected, then this Court has effectively condoned a practice which makes the trial of the issue of validity of a patent superfluous. If the evidence in this case is deemed sufficient to overcome the presumption of validity, then a plaintiff could introduce his patent; a defendant would introduce the prior art; and the trial judge would determine whether or not the invention was obvious to him. This is not in conformity with *Graham v. John Deere, supra.*

Upon the merits it will be shown that the trial court erred in failing to follow the criteria of *Graham v. John Deere, supra,* and because its findings were not supported by the evidence.

II. A Second Significant Problem Not Resolved by the Decision of the Seventh Circuit Is the Disposition of Patent Cases on Appellate Review.

Appellate federal courts, including this Court, are not constrained from making the factual inquiry required by *Graham* to sustain or reverse the conclusion of validity.[5] Why is this so? Appellate review of patent cases should be no different than other types of cases. The fundamental purpose of appellate review is to determine if the trial court erred, not to substitute its opinion on validity for the opinion of the district court. If a trial court has erred in the law by failing to make the inquiry required by *Graham* or if its findings are not supported by the evidence, the case should be reversed for the trial court to make its decision based upon the evidence before

[5] This writer knows of no patent case in which the appellate court recognized that the trial court was better able to make the factual inquiry required by *Graham* although in error in failing initially to either make the inquiry or properly apply the criteria of the inquiry to the evidence.

it and upon the inquiry required by *Graham* or for a new trial. Although appellate courts might arrive at a different conclusion than did the trial court, if the conclusion is supported by the evidence and it is made without error in the law and by proper application of the inquiry of *Graham*, the judgment of the trial court should stand.

It is recognized that patent trials are expensive, *Blonder-Tongue Labs. v. University Foundation*, 402 U.S. 313, 335 (1971). As long as litigants have "hope" of substituting appellate "opinion" of obviousness or non-obviousness for that of the trial court, most patent cases will be appealed. If appellate courts agree with the initial conclusion of validity or invalidity, Rule 52(a) is particularly felicitous, see *Novo Indus. Corp. v. Standard Screw Co.*, 374 F.2d 824 (7th Cir. 1967), cert. denied, 389 U.S. 823 (1967); if they disagree, appellate courts rely upon the fact that validity is a question of law and they suggest that they are as equally qualified (perhaps better) as the trial court to review the prior art; determine the difference between the prior art and the invention; and conclude invention or no invention. See *L & A Products, Inc., et al. v. Britt Tech Corp., et al.*, 365 F. 2d 83 (8th Cir. 1966).

Uniformity and fairness in the application of the patent laws, desired by all, has been given an impetus by *Graham* but it shall come to fruition only by a change in appellate review of patent cases.

It is unfortunate that the Seventh Circuit here did not render a decision which would have forthrightly met the issues of error asserted by Plaintiffs and satisifed Plaintiffs that justice had been done. A patentee, of course, does not like to have his patent held invalid; but if a defendant introduces the evidence required by *Graham*, if the trial judge makes the inquiry required into such evidence, and if the evidence supports

the conclusion of the trial judge, a patentee will understand the adverse judgment and accept it although he may not agree. It is for appellate review to determine whether the trial judge erred. A reversal of the trial court in patent cases today reflects more a difference of opinion than error; and until there is a change, full understanding and proper application of *Graham v. John Deere* will elude a large percentage of the trial judges.

Of course, it is recognized that there will be difficulties in applying the non-obvious test of *Graham v. John Deere*, see *supra* at 18; and even strict application and observance of the requirements of *Graham* may result in different opinions by different judges. However, it is more important for appellate judges to determine whether the trial judge made strict observance of the requirements of *Graham v. John Deere, supra*, than to substitute their opinion for the opinion of the trial judge on a conclusion of patentability. It is time that this Court and the United States Circuit Courts of Appeal treated patent cases on appellate review the same as any other case.

CONCLUSIONS

In the interest of a competent and fair determination of the validity and infringement of a patent, this case should be reviewed. It must be emphasized to the District Courts that actual evidence has to be before the trier of fact in support of the factual issues of *Graham v. John Deere*, which issues must be resolved in order to determine validity. Further, this case offers the Court an opportunity to rectify the unorthodox, judicially time-consuming practice of the appellate courts in deciding patent cases de novo. Grant of the Writ is respectfully petitioned.

Respectfully submitted,

JOHN D. GOULD
ROBERT T. EDELL
MERCHANT, GOULD,
SMITH & EDELL
Professional Association
1630 Midwest Plaza Building
Minneapolis, Minnesota 55402
Counsel for Petitioners

APPENDIX

UNITED STATES COURT OF APPEALS
For the Seventh Circuit
Chicago, Illinois 60604
Argued October 16, 1973
November 7, 1973
Before
Hon. Luther M. Swygert, Chief Judge
Hon. Latham Castle, Senior Circuit Judge
Hon. Robert A. Sprecher, Circuit Judge

KERMIT H. WILSON, et al.,
Nos. 72-2031, 72-2032
Plaintiffs-Appellants and Cross-Appellees,
vs.
MIDWEST FOLDING PRODUCTS MANUFACTURING CORPORATION, et al.,
Defendants-Appellees and Cross-Appellants.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division, No. 71 C 190, Philip W. Tone, Judge.

ORDER

In No. 72-2031, the plaintiffs appeal from a judgment in a patent infringement case holding that Claims 1, 6, 7, 8 and 9 of Patent No. 3,055,705 are invalid and that if those claims were valid, defendants' accused devices do not infringe them.

In No. 72-2032, the defendants appeal from the failure of the judgment to find fraud on the Patent Office and unclean hands, and the denial of relief therefor, including attorneys' fees.

We affirm the judgment as to both appeals and we adopt as part of this order the memorandum of decision, findings of fact and conclusions of law of the district court entered on October 10, 1972.

AFFIRMED

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

No. 71 C 190

KERMIT H. WILSON and SICO INCORPORATED,
Plaintiffs,

v.

MIDWEST FOLDING PRODUCTS MANUFACTURING CORP. and MIDWEST FOLDING PRODUCTS SALES CORPORATION,
Defendants.

MEMORANDUM OF DECISION
AND
FINDINGS OF FACT AND
CONCLUSIONS OF LAW

MEMORANDUM OF DECISION

PHILIP W. TONE, District Judge.

The alleged invention in suit consists of a combination of old elements in the field of mechanics. The Supreme Court's admonition in *A. & P. Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 152 (1950) is applicable:

> "The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. Elements may, of course, especially in chemistry or electronics, take on some new quality or function from being brought into concert, but this is not a usual result of uniting elements old in mechanics."

This "rather severe test" has not been relaxed or altered by the Patent Act of 1952, 35 U.S.C. §§ 101, 102, 103. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 19 (1966).

The standards of invention that must be applied are novelty, utility and obviousness. The utility of the alleged invention is not in issue. Novelty is another matter. Folding tables are old in the art, as are folding tables with attached benches. It is at least doubtful whether the mere substitution of individual seats for benches satisfies the requirement of novelty, but in any event the patent fails under the test of obviousness.

The standard we are to apply in determining obviousness is prescribed in the *Graham* case (383 U.S. at 17-18):

> "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy."

The alleged invention consists of a folding table with attached individual seats, all parts of which fold for storage into a relatively compact arrangement. The table is used in school cafeterias and for similar institutional purposes. Prior to the time the alleged invention was developed there were in use folding tables with attached benches, all parts of which folded for storage into a relatively compact arrangement. Plaintiff Wilson became aware of a demand for a table with individual seats rather than benches and set out to design one. He testi-

fied that 90 percent of the design was done in three to four weeks and that the last 10 per cent took the balance of the year. In designing the table Wilson would develop the principle and then turn it over to an engineer to get the exact pivot points and "other" details. Essentially the alleged invention Wilson claims consists of

(a) two table top sections interconnected by hinges,

(b) legs that remain essentially vertical in both the folded and unfolded positions,

(c) seats that remain essentially horizontal in both positions, and

(d) linkage, control arms and pivot points which maintain the legs and seats in the desired vertical and horizontal postures, whatever the position of the table, with configurations that permit folding into a relatively compact arrangement.

In addition, the specifications, though not the claims, refer to a torsion bar, which is a source of energy to assist in the folding operation, and means of transmitting the energy released by the bar.

The foregoing combination is described in the patent claims and specifications with the verbosity customary in these matters, but essentially what is described above is all that is involved.

None of the elements listed above was new. I find that Wilson's combination of them would have been obvious to any person having ordinary skill in the art. Any person having ordinary skill in the art who set out with the same goal Wilson had would have developed essentially what Wilson developed and what Wilson attempted to patent. Examination of the prior art, listening to the witnesses skilled in the art, and viewing the structures embodying the alleged invention convinces

me that any company in the institutional table business that wanted to develop such a table and seat structure could have done so merely by assigning the design task to its design and engineering personnel. There is nothing in plaintiff's structure that amounts to invention. I find all claims in issue invalid.

In addition, for the reasons stated in the findings, I find that the claims are not infringed.

The Patent Office, in rejecting the initial application for the patent in suit, reached the same conclusion I have reached as to obviousness. (File Wrapper, pp. 22-23, 27.) Defendants allege that the patent ultimately issued because of conduct by the applicant which amounts to fraud on the Patent Office and unclean hands. The history of the proceedings in the Patent Office does not, in my opinion, sustain these affirmative defenses, in view of (a) the applicant's contention in the Patent Office that it was the combination of concededly old elements, rather than the introduction of any new element, that amounted to invention, and (b) the knowledge of the art which the patent examiners who handled the matter presumably had, and must have been believed by the applicant to have had, in view of their exposure to the prior art, as stated in the findings below. Nevertheless that history is pertinent because it shows the ease with which the Patent Office, which originally recognized the absence of invention in plaintiff's development, was beguiled and cajoled into issuing a patent which never should have been issued. This subject is dealt with, together with the other issues, in the findings below.

FINDINGS OF FACT

1. Plaintiff, Sico, Inc., is a Minnesota corporation having a principal place of business at Edina, Minnesota. Plaintiff, Kermit H. Wilson, is the President, founder and principal

stockholder of Sico and is the patentee of the patent in suit, No. 3,055,705, entitled "Folding Table and Seat Structure," dated September 25, 1962.

2. Defendant Midwest Folding Products, Inc. is an Illinois corporation which manufactures folding table and seat structures charged to infringe. Defendant Midwest Folding Products Sales Corporation is an Illinois corporation having common ownership with the other defendant which handles the sales of all products of the other defendant. The defendants will be referred to collectively as Midwest.

3. Plaintiffs charge infringement of Claims 1, 6, 7, 8 and 9 of the patent. It is charged that the manufacture, use, or sale of the defendants' 4012 and 4016 models infringes each of the claims 1, 6, 7, 8 and 9 of United States Letters Patent No. 3,055,705, and the manufacture, use, or sale of the defendants' 4008 model table infringes each of claims 6, 8 and 9 of the patent.

4. Under the pleadings as amended, and the final pretrial order of August 1, 1972, the issues before the Court are validity and infringement and whether plaintiff should be denied relief by reason of unclean hands or fraud on the Patent Office. Any issues as to monetary relief were deferred pending a determination of liability.

5. Prior to the alleged invention of the patent in suit, the portable table and seating art was highly developed and included folding tables with benches and individual seats with mechanisms for integrating their operation and folding. The development of folding tables with individual seats was, as Wilson testified, "in effect cutting slots in those benches, you might say."

6. Wilson's patent in suit covers a combination of a folding table with seat structure, each element of which, were old in

the prior art. The use of individual seats in combination with a folding table was old in the prior art. Linkage mechanisms, including control arms and pivot arrangements, for folding tables with seat structures were old in the prior art.

7. Wilson's three prior art patents, Nos. 2,873,157, 2,747,958, and 2,831,741 (Exhibit 38) show center-fold tables with two table tops connected by a hinge, V-shaped control arms having a torque spring at the bottom point where the arms are connected to pivot with each other, and which are connected at their outer ends to the underside of the respective table tops, and which control arms are additionally pivotally connected through links to the leg structures to maintain the legs in a parallel, vertical relationship during folding and unfolding.

8. The shape of leg structure disclosed in the patent in suit for supporting a seat structure, namely, one having an upper vertical portion, a lower vertical portion and a connecting horizontal portion, is old in the prior art, as shown in the Wilson Patent Nos. 2,721,778 and 2,771,937 and Taylor, No. 2,908,322; Holic, No. 2,690,210 and Loibl, No. 2,613,728.

Patent In Suit

9. The Wilson patent in suit, No. 3,055,705, shows and describes a pair of table top sections hinged together at the center. It shows seats positioned adjacent to each of the sides of the table top sections and shows and describes a specific form of what is described as a "novel" linkage mechanism for operating the table and seats, wherein the table top sections are positioned horizontally in "in-use" position, and wherein the table top sections are then folded inwardly towards each other so that they extend in an upright position to occupy a minimum of space when the table and chairs are in "non-use" position.

10. The individual seats are shown to be supported on leg structures which are pivotally connected to the table top sections. The leg structure comprises pairs of legs, each having an upper vertical leg portion 15 and a lower vertical leg portion 17 connected by an intermediate horizontal portion 18, with the individual seats supported by the lower leg portion and overlying the intermediate portion of the legs. There are three pairs of longitudinally spaced legs, 9, 10, 11 and 12, 13 and 14, connected to each table top section. These are the inner, intermediate and outer leg structures (See Col. 2 of patent in suit) and are connected respectively to the inner end portions, the intermediate portion and the outer end portion of the table top sections. There is no center leg structure common to both table top sections.

11. The operating linkage for operating the table and seats includes a pair of rigid links 23 and 24 which extend under each of the table top sections and connect the outermost leg structure, the intermediate leg structure, and the innermost leg structure together so that they all operate simultaneously.

12. The operating linkage also includes a specific form of control arms which comprise two pairs of such control arms, one pair comprising control arms 34 and 36 and the other pair comprising control arms 33 and 37. Each pair of control arms are connected at their inner ends as at 40 to form a conventional V-shaped configuration. The V-shaped control arms at their point of connection to each other are provided with a torsion bar 44 for the purpose of storing the energy to operate the table from the horizontal "in-use" position to the vertical "non-use" position. The other ends of the V-shaped control arms are in turn connected to the table top sections and to the leg structures. All of these connections are essential and breaking of any of them results in an inoperative structure.

13. The V-shaped control arms are always in a V-shaped configuration throughout their operation. When the table is positioned in its horizontal "in-use" position, as shown in Fig. 2 of the patent, the arms 34 and 36 of the V-shaped control arms are in their widest angle or spread-apart the farthest. As the table is moved to its partially folded position, as shown in Fig. 8 of the patent, the V-shaped control arms 34 and 36 close the spread between the arms and as the table is moved to its fully closed position, as shown in Fig. 4, the V-shaped control arms are at the narrowest distance between each other. The patent in suit shows only a single torsion bar only at the connecting or lowermost point of the V-shaped control arms.

14. The torsion bar performs an important function in that when the table sections are positioned in their horizontal "in-use" position, the torsion bar is twisted to store up energy so that when it becomes necessary to fold the table it can be folded by a single operator by engaging the handle 56 and moving it upwardly. The single torsion bar 44 supplies the necessary energy for moving the table tops to their vertical and closed in position.

15. If the torsion bar were eliminated it would be impossible or extremely difficult for a single individual to raise the table sections from their horizontal to their vertical position. Thus, to achieve the objectives of the patent in suit the torsion bar is essential to the operation of plaintiff's patented device.

16. Plaintiffs' Exhibit 21 exemplifies the patented structure as shown and described in the patent in suit, with the V-shaped control arms and single torsion bar at the connecting or bottom point of the V-shape, as well as the other linkage necessary to make the table operate.

17. Plaintiff manufactured and sold approximately 1,000 of these tables (PX 21), and thereafter discontinued the manufacture and sale of these tables. Plaintiff converted to a table operative through a different linkage mechanism, exemplified by PX 23.

Plaintiffs' Commercial Structure PX 23 Is Covered by Another Patent Not In Suit.

18. Plaintiff's commercial embodiment (PX 23) is shown and illustrated in plaintiff's Patent 3,075,809, filed less than two months after the filing of the patent in suit. The '809 patent is not involved in this suit but does exemplify plaintiff's commercial structure sold from 1960 to date. The '809 patent (PX 23) eliminates the V-shaped control arms 34, 36, 33 and 37, eliminates the single torsion bar 44 at the connecting or bottom point of the V-shaped control arms and in lieu thereof utilized an entirely different linkage mechanism as follows.

19. It utilizes a pair of short links 32 and 33, best shown in Fig. 5 of the '809 patent, which cross each other to form an X-shaped configuration. These short X-shaped links are not connected to each other and do not have a torsion bar. The X-shaped short links 32 and 33 are positioned immediately under the hinge point or the center of the two table top sections. Plaintiff's commercial structure (PX 23) exemplified by the '809 patent (not in suit) utilized four torsion bars 40, which are directly associated with the leg structure at the upper end thereof and are positioned directly under and connected to the table tops.

20. The short links 32 and 33 in the '809 patent (not in suit) which form the X-shape do not operate in the same manner as the V-shaped control arms 34, 36 and 33, 37 of the patent in suit. The four torsion bars in the '809 patent and in plaintiff's commercial structure (PX 23) by virtue of their

position and direct connection to the underside of the table top do not operate in the manner of the single torsion bar 44 at the center of the V-shaped control arms of the patent in suit.

21. In the patent in suit the V-shaped control arms are positioned in a normal V-shaped configuration and with the single torsion bar 44 for storing energy at the connecting or bottom point of the V. The torsion bar is thus centrally positioned at the lowermost end of the operating linkage and, as seen in Fig. 2 of the patent in suit, is positioned in direct vertical alignment with the center or hinge axis of the table in position. When the control arms operate through the torsion bar 44 to the intermediate folding position of Fig. 8 the single torsion bar is in the same vertical alignment with the center or hinge axis of the table tops. When the table is in fully folded position as shown in Fig. 4, the torsion bar is still in the same vertical alignment with the center or hinge axis of the table. Thus, the stored-up energy in plaintiff's patented unit is derived from the single torsion bar, always in vertical alignment with the center between the table top sections.

22. In the patent in suit the torsion bar or energy storing means 44 is located at the exact center of the length of the table when the table is in horizontal "in-use" position of Fig. 2. The torsion bar in this position is located a short distance above the floor surface and a considerable distance from the table tops. In this position the torsion bar is "loaded" with stored energy and is the lowest point in the linkage assembly. It is positioned below both the level of the individual seats and the level of the horizontal portion of the leg structures.

23. In contrast, in plaintiff's commercial embodiment PX 23, as exemplified in Patent 3,075,809, there are four torsion bars 40, and they are located (best shown in Fig. 5 of said

patent) at the top immediately adjacent and are connected to the underside of the table sections when the table is in "in-use" or horizontal position.

24. The four torsion bars are not in vertical alignment with the axis of the hinge and are not in the exact center of the length of the table. The four torsion bars are thus positioned above the plane of the linkage, above the top plane of the seats and above the horizontal portion of the leg structure. This different type of construction operates in a different manner from the structure covered by the patent in suit.

25. Plaintiff's commercial structure (PX 23) has different linkage and control mechanisms which operate in a different manner from the linkage control mechanisms of the patent in suit.

26. By virtue of the differences in structure between PX 23, plaintiff's commercial unit, and PX 21, plaintiff's patented unit, the commercial success which has been achieved by PX 23 cannot be attributed to the patent in suit.

27. In addition, plaintiff's commercial units bear the notice of five different patents, including Design Patent No. 211,886. There is no evidence to show that all or part of any commercial success was not due to the other patents not in suit.

Defendants' Development.

28. Defendants' development of the accused structure resulted from requests from defendants' dealers for Midwest to add a folding table with individual seats to its line. At that time, about 1968, there were several competitors that had tables with individual seats.

29. Defendants' President, Lester Speyer, requested Daniel Haunost, an engineer who had done consulting work for defendants in the past, to design a folding table with individ-

ual seats and requested Haunost to use, as a basis for the table with seat structure, stock parts already incorporated in Midwest's existing production tables. Defendants' 1012 table, which had been developed several years earlier, incorporated a center leg structure common to both table top sections, having a plate which had two pivot points with two intermeshed gear segments mounted thereon, the purpose of which was to maintain the table tops at equal angles to the vertical and also to transmit forces used to maintain the legs in a parallel vertical relationship during folding and unfolding, all identical in operation to the accused table with stools. The geared drive mechanism utilized in the 1012 table was utilized in the accused table with seat structure. This gear drive mechanism had been patented by Haunost and assigned to Midwest, U.S. Patent No. 3,159,114, issued December 1, 1964.

30. Haunost developed the accused structure by modifying the lower portion of the center leg structure of the 1012 table to add horizontal intermediate leg elements to carry lower leg elements which were positioned outside the edge of the table where a person would sit. The outer leg structures were similarly modified with the lower leg structure positioned where an individual would sit and also placed outside the plane of the upper leg portion in order to provide a stability when the table with seats was in a folded position, to prevent the seats from hitting each other when in the folded position, and to provide symmetry of all legs.

31. Defendants' accused structure was developed without reference to the patent in suit or any of the versions of plaintiffs' TC 65 table.

Defendants' Accused Table (PX 25)

A. *Structure.*

32. Defendants' accused table, which is exemplified by PX 25, employs a structure which is visibly, mechanically, and physically different from the patented structure, in the mechanism for operating and transmitting of forces and in the other elements, and operates in an entirely different manner from the patent in suit.

33. PX 25 consists of a pair of table top sections connected together at their inner ends by a pair of meshed gears. Each of these gears has its own axis of rotation. The gears provide an essential element in the transmission of forces and overall operation of defendants' accused structure. (This gear arrangement is the subject matter of defendants' U.S. Patent No. 3,159,114.) There are two pairs of longitudinally spaced legs connected to each table top section. These are connected respectively to the outer end portions and the intermediate portions of the table top sections. There is additionally a center leg structure which is connected to the two axes of pivot of the meshed gears and is thus common to both table top sections. The center leg structure carries two pairs of lower leg portions but there is only a single, common vertical upper portion.

34. PX 25 has no control arms. There is a long link parallel to the table top pivotally connected at its ends to the common center leg structure and to the outer leg structure. There is a second shorter link connecting the outer and intermediate leg structure. Neither of these links is connected to the table top sections, as is true and essential in the structure of the patent in suit.

35. There are two torsion bars in defendants' accused structure and each of these is connected directly to an outer leg structure and its associated table top section; thus, the

stored motive energy is positioned at the outer end portion of the table top and at the highest point in the structure, well above the horizontal plane of the seats. There is thus no motive stored energy positioned below the center of the table and the plane of the seats as in the structure of the patent in suit.

36. When defendants' accused structure is in the horizontal "in-use" position, the two torsion bars are located near the outer end portions of the entire table and farthest removed from the center of the table. This is in sharp distinction from the structure of the patent in suit where a single torsion bar is positioned in vertical alignment with the center axis of the hinge connecting the table top sections together.

37. The inner ends of the long links are not connected together on a common axis of pivot and do not have a torsion bar at a common axis of pivot as is the case with the V-shaped control arms in the structure of the patent in suit.

B. *Operation of Defendants' Structure PX 25.*

38. The two torsion bars, outer pairs of legs and the table top sections are preloaded or stored with potential energy, when the table is horizontal, tending to pivot the table top sections into parallel relationships with those pairs of legs. The operator applies sufficient lifting force to overcome the mechanical equilibrium and cause the torsion bars to unwind. The resulting torque, which tends to rotate the inner ends of the table top sections away from one another, is transmitted through table top sections to the gear segments. The meshed geared segments are caused to rotate and themselves transmit a lifting force to the center leg structure which is connected in common to the two axes of pivot of the gear segments. The long links connected to the center leg structure move upwardly with the center of the table and themselves transmit force to the outer pairs of legs tending to draw them together. The

short links retain the outer and intermediate leg pairs parallel and vertical. The center leg structure always bisects the angle between the table top sections and is always vertical because of its common connection to the two pivot axes of the gears. The inner ends of the long links are maintained a fixed distance from the center of the table and move upwardly with the center of the table.

Operation of Patented Structure PX 23.

39. In the patented structure, the single torsion bar is connected in common to the two pairs of control arms which are arranged in a V-shaped configuration at the lowermost point of the V and in vertical alignment with the center axis of the hinge. That single torsion bar is preloaded or stored with potential energy, when the table is horizontal, tending to draw the control arms together and fold the table. The operator applies a lifting force sufficient enough to overcome the mechanical equilibrium and the torsion bar begins to unwind. The control arms rotate in opposite directions (toward one another) and the force transmitted through the arms draws the table top sections together through the links 31 and 32, which connect the outer ends of the control arms to the table top sections. The outer end portion of the control arms are additionally connected to the intermediate pairs of legs 10 and 13. The motion of the control arms causes the connecting link elements 46 and 47 to move and pivot the intermediate leg pairs 10 and 13. Through the rigid links 23 and 24, all three leg pairs of each set (9, 10, 11 and 12, 13, and 14) pivot in unison. In contrast, defendants' structure PX 25 has only two pairs of legs in each set pivoting in unison and a common center leg structure whose orientation with respect to both sets of leg pairs never changes.

40. Throughout the described folding operation of the patented structure, the single torsion bar and the V-connected inner ends of the control arms move away from the center of the table. However, the single torsion bar always is maintained in vertical alignment with the center of the table. In contrast, the two torsion bars in defendants' accused structure are never in vertical alignment with the center of the table. Finally, the hinges 5, 6, and 7 permit the table top sections to fold and pivot about the pintle or axis 7. This is in contrast to defendants' accused structure wherein the meshed gears and center leg structure themselves play a vital part in the transmission of forces.

41. Defendants' accused structure has different structural elements arranged in a different way, and operates in a different manner from the patented structure.

The Prior Art.

42. Mackintosh Patent No. 2,788,059, issued April 9, 1957, on application filed June 20, 1952. This prior art patent illustrates and describes a fully integrated folding table-seat structure having four individual seat elements and linkage for folding the structure and maintaining the legs in a vertical parallel relationship. This structure is most clearly shown in Figs. 29-32 of the reference, wherein the table top sections 500 and 501 are connected together by hinge 505. The table top sections are supported by a pair of leg structures 510 and 550, each of which comprises an upright member 514, a lower leg portion 537, interconnected by a horizontal bar 536. There are individual seat elements 540 and 541, two on either side of the table, each supported by an adjacent pair of lower leg portions 537. There are operating links 520 arranged in an X-configuration and connected to the table top sections and inner leg structures 550. The entire structure folds up into a vertical

folded condition in which all of the elements are in substantial parallelism, as shown in Fig. 31. In this structure, the seat elements 540 and 541 additionally function as linkages connecting adjacent parts of legs 510 and 550.

43. Mackintosh further discloses, in Figs. 25-28 of the patent, a folding table wherein short links 455 are substituted for and perform the same function of interconnecting adjacent pairs of legs 410 and 450 to maintain them in parallelism. The Mackintosh patent goes on to describe in col. 10, lines 3-13, that the links 455 and seat elements 540 and 541 are interchangeable. Mackintosh teaches further (col. 10, line 29):

> "It will be noted that in this embodiment, as in all of the other modifications wherein benches are provided, the leg frames are so constructed and arranged that the table top supporting portions are connected to the bench supporting portions only by a transverse bar at floor level, thus presenting no impediment to movement along the spaces between the benches and the table proper."

Although the Examiner cited Mackintosh during the prosecution of the patent in suit, he never made reference to the embodiments shown in Figs. 26-32 and to the description alluded to above.

44. Defendants' physical exhibit DX 55, made by Haunost, exemplifies in miniature form the disclosure of the Mackintosh patent, namely, Figs. 25-28 and Figs. 29-31. It covers an institutional-type mobile table with attached seats in the form of benches, and operating links, all integrated so that the table may be positioned horizontally for "in-use" position and collapsed by centrally folding the table so that the two table tops are vertically positioned and in this position may be stored away, with the operating linkage confined between the two table tops, all directed to the same purpose as the patent in suit.

45. Mackintosh further teaches the use of the equivalent of torsion bars, Col. 1, Line 55, to enable the entire unit to be folded and unfolded with minimum effort, similar to the patent in suit.

46. Mackintosh teaches, Col. 1, Line 60, the use of a wide hinge means at the joint of the table so that when fully folded and stored sufficient space is provided between the adjacent panels or table tops to accommodate the legs and linkages, similar to the patent in suit.

47. Mackintosh teaches, Col. 2, Line 10, providing gaps between the bench sections through which diners or others may pass in order to occupy their seats, without the necessity of stepping over the benches or sliding along the benches, all away from the outer end of the installation. In effect, the benches in Mackintosh serve the same purpose as the spaced seats in the patent in suit.

48. Mackintosh teaches and discloses the use of wheels or rollers on the leg structures so that the folded table may be readily rolled away in the same manner as the patent in suit.

49. The Mackintosh patent, clearly embodied in the model DX 55 shows four seating members, namely, benches positioned on the opposite sides of the two folding table sections, and these benches are connected by linkages and leg constructions as an integrated unit requiring no manipulation or adjustment and wherein the seat elements move with the movement of the coordinated table elements from horizontal seating to vertical storage position.

50. The Mackintosh model DX 55 further illustrates the ease with which individual seats or stools can be substituted for each of the benches. The substitute seats or stools exemplified in this model are old and well-known in the art. The model demonstrates the ease with which the benches may be

removed and individual seats substituted. There was no need to reconstruct or modify the Mackintosh structure to substitute the seats for the benches. The model can be moved from the horizontal in use position to vertical folded non-use position for storage and vice versa and no adjustment of parts or elements is needed, except that the leg structures would have to be bent if benches on both sides are replaced with stools, to enable the unit to fold with maximum compactness. Bending the leg structure would be an obvious expedient to one with ordinary skill in the art. The substituted seats always remain in a horizontal position, like the individual seats in the patent in suit. The seats are horizontal when the table tops are in horizontal or in-use position, stay in horizontal position when the table tops are moved to partially folded position, and remain in horizontal position when the table tops are in fully folded vertical position, precisely as shown in the patent in suit.

51. The use of individual seats for use with a folding table is shown in several of the prior art patents. Furthermore, the concept of the use of individual seats integrated with a folding table, in lieu of benches, was suggested to Wilson by his customers, and therefore the concept of individual seats was not Wilson's.

52. No invention was involved in the substitution of the old and well-known individual seats or stools for the benches, as demonstrated by the Mackintosh model DX 55.

53. The teaching of the substitution of the stools or seats in lieu of the benches in Mackintosh would have been obvious to anyone skilled in the art as of the time of the alleged invention of the patent in suit.

54. Neil Clark, called as an expert by plaintiffs, testified that if the individual seats in the model PX 55 touched each

other when the table was folded to collapsed position that it would not be obvious to the man skilled in the art to bend the leg structure. This discredits Clark because common sense tells us that, as stated above, the bending of the leg would have been an obvious expedient to anyone skilled in the art.

55. In its initial action rejecting all claims the Patent Office correctly perceived that the cited Mackintosh patent anticipated the alleged invention in suit.

56. The form of leg structure described and claimed in the patent in suit is shown in combination with a folding table structure in each of the following prior art patents:

Weinbaum No. 2,019,374 (Fig. 3)

Bennett No. 2,502,502 (Fig. 1)

Loibl No. 2,613,728

Holick No. 2,690,210 (Fig. 2)

Wilson No. 2,721,778 (Figs. 2 and 9)

Wilson No. 2,771,937 (Figs. 1, 2 and 9)

Taylor No. 2,908,322 (Fig. 2)

57. The following prior art patents show folding table structures in combination with individual chairs:

Weinbaum No. 2,091,374

Bennett No. 2,502,502

Loibl No. 2,613,728

58. The evidence and testimony at the trial demonstrated that it would have been obvious at the time of the alleged invention of the patent in suit for one skilled in the art to provide a folding table having a pair of table top sections, a plurality of pairs of legs of the particular shape in question, and individual seats mounted on each of the legs, and a linkage mechanism for folding the table and maintaining the seats in a horizontal relationship.

Invalidity

59. In light of the prior art referred to in the foregoing findings and the level of ordinary skill in the table-seat art as shown by witnesses who testified, it would have been obvious to one having ordinary skill in the art, at the time of the alleged invention of the patent in suit, to make the structure defined by the claims in suit.

60. The Patent Office did not cite certain pertinent prior art, *viz.*, particularly the Weinbaum, Loibl, Taylor and two Wilson prior patents 2,721,778 and 2,771,937, which are relevant to the alleged invention.

61. Claim 6 (original claim 9) was inserted in the patent in suit to cover a structure wholly outside of and different from the invention of the patent in suit. That structure is shown and described in Wilson Patent No. 3,109,678 and covers a single section, non-center-fold table similar to a common folding bridge table wherein the table falls to the floor when the legs are folded. There is no disclosure or teaching in the patent in suit of a table having a unitary table top which does not fold in the center, with legs maintaining a parallel, vertical relationship, and such table is not within any invention of the patent in suit. Dependent Claim 9 also refers to such table.

62. Claim 6 is additionally anticipated under 35 U.S.C. § 102 because every element claimed and its corresponding function is taught by the following patents: Loibl, No. 2,613,728; Wilson, No. 2,721,778; and Wilson, No. 2,771,937.

63. Claim 8 (original Claim 11) was added to the patent in suit by amendment after rejection of all original claims some twenty months after the first public sale of the patented structure in December of 1959. This claim was directed to a "new development," a table having seats on only one side

thereof, and broadened the coverage of the patent from that originally sought. The addition of this claim was not accompanied by a Supplemental Oath as required by Rule 67 of the Patent Office Rules of Procedure.

64. Claim 8 covers a structure having seats on only one side of the table and different types of legs on the opposite side. This construction is not shown or described in the description of the invention in the specification of the patent.

65. The essential elements of the combination recited in Claim 8 is the mechanism for operating the patented structure:

> "Linkage operatively connected to said top sections and to said leg structures for maintaining said leg structures in a generally vertically disposed position,"

in Claim 8 describes this structure in terms of what it does rather than what it is and thus defines this element in functional language. This fault is not cured by the specifications.

66. The claims of the patent in suit fail to recite and include a torsion bar or equivalent energy storing means. The torsion bar in plaintiff's structure is an essential element to the combination. To perform the objectives recited and stated in the patent in suit, the torsion bar or some other energy storing means and means of transmitting the energy to aid in the operation of the table are essential. As there is no reference to such means in the claims of the patent in suit, the plaintiffs' patented structure would be inoperative as a practical matter for the purpose intended. The claims are, therefore, incomplete and indefinite.

67. The importance of the torsion bar in relation to the claims is apparent when the claims of the Wilson commercial Patent No. 809 are read. In the claims of that patent, the tor-

sion bar and its function is recited as a positive element of the claims to make them operative.

68. Original Claim 7 showed spring means on the control arms to urge them so as to move the top sections to their upright folding positions. This was rejected as old in the art.

69. Claim 6 and dependent Claim 9 are directed to a non-folding table having a single rigid table top section and which, when the legs are folded up, falls to the floor. The description of the invention in the specification of the patent does not cover any disclosure such as set forth in these claims.

70. Claims 6, 8 and 9 cover alleged inventions other than that described and contemplated in the patent in suit.

Defendants' Structure Does Not Infringe
The Patent Claims in Suit.

71. As heretofore stated in these findings, the defendants' structure operates in a different way from the patented structure. Accordingly, there is no identity of means, operation and result in defendants' structure when compared with the patent claims in suit. When interpreted, as they must be, in the light of the specification, prior art and history of the prosecution of the application in the Patent Office, the claims in suit, even if valid, are not infringed by defendants' structure.

72. Plaintiffs' expert, Neil Clark, attempted to read main Claim 1 of the patent in suit on defendants' structure PX 25. The claim calls for hinged means connecting the table tops. The defendants' structure utilizes a pair of meshed gears which are an integral and important part of the linkage and drive the mechanism of defendants' structure. Clark testified that removal of the said gears would render the defendants' structure inoperative.

73. In the patent in suit the hinge means have a single axis and play a passive part. In defendants' construction PX 25,

the meshing gears, each of which is on a different axis in contrast to the single axis of plaintiffs' passive hinge, play an active part in maintaining the relationship of the top pieces in the folding and unfolding operation. The defendants' structure does not employ the hinge means as claimed in any of the claims of the patent in suit.

74. Claim 1 calls for longitudinally inner and outer generally vertically disposed leg structures pivotally connected to the inner and outer end portions respectively of the top sections. The patent in suit discloses and describes three leg structures on each side identified as the inner, the outer and an intermediate leg structure, with the inner and outer leg structures coordinated and connected by a link to the intermediate leg structure. The defendants' structure (PX 25) does not have a rigid connecting link which connects the inner, outer and intermediate leg structures. In defendants' construction the outer leg and the intermediate leg structure are connected, but that link does not extend to nor does it connect to the inner leg structure. In defendants' construction the inner leg structure is connected to the outer leg by a second link and not as called for in Claim 1 of the patent in suit.

75. Claim 1 calls for a pair of rigid links extending generally longitudinally of the top sections and each pivotally connected at its opposite ends to the inner and outer leg structures. The patent in suit shows and describes long rigid links 23 and 24 which are connected at the opposite ends to the inner and outer leg structures 9, 11, 12 and 14. Those links are additionally connected to the intermediate leg structures 10 and 13 of the patent in suit. Defendants' construction PX 25 utilizes a short link connecting the outer and intermediate leg structures and that short link is not connected to the inner leg structure as required in Claim 1.

76. Claim 1 further calls for "a pair of control arms underlying the inner end portions of the top sections." These are elements 34 and 36 of the patent in suit which are arranged in a conventional V-shaped configuration when the table is horizontally positioned and when it is in folded position (see Fig. 8 of patent in suit). Defendants' structure does not utilize control arms like 34 and 36 of the patent in suit which join at the lower end to form a common pivot point.

77. Claim 1 additionally calls for "means operatively pivotally connecting the control arms at their inner ends" for the recited function. These means are the common axis 40, 41 and the torsion bar 44. Defendants' construction does not utilize a structure as claimed. Defendants' rigid links are not connected together on a common axis to form a conventional V-shaped configuration. There is no torsion bar at that missing common axis, and the links in defendants' construction are not arranged in the conventional V-shaped configuration.

78. Claim 1 further calls for "the outer end portions of the arms being each operatively pivotally connected to a different one of said top sections *and* associated leg structure." Defendants' long links have only a single connection at their outer ends, and that to the outer leg structure along. There is no connection to the top as called for in Claim 1.

79. Claim 1 does not read on defendant's structure.

80. Claim 6 recites "In a combination table and chair structure." Claim 6 thus covers a nonfolding table, having but a single, rigid table top section, as admitted by plaintiffs' expert, Clark. Defendants' structure PX 25 is not a nonfolding table as called for in Claim 6, but is a folding structure having a pair of table top sections which are not covered by Claim 6. Additionally, Claim 6 calls for supporting means which refers to everything which holds up and supports the

table, including all of the linkages, namely the rigid links and the actuating arms shown in the patent in suit. Defendants' structure does not have such supporting means.

81. Claim 8 includes, as an element of the hinge, means which the defendants' structure does not employ, since the hinge means shown in the patent is a passive hinge which pivots about a single axis, whereas defendants' structure employs a pair of meshing gears, each on a separate axis.

82. Claim 8 further calls for "a linkage operatively connected to said top sections and to said leg structures" for achieving a stated function. The expression "a linkage operatively connected" is meaningless and purely functional unless it is construed with particular reference to the description and drawing of the patent in suit. The patent in suit shows the linkage to be the control arms, the V-shaped configuration, the torsion bar, the common axis of pivot, the rigid links 23 and 24 and all of the various connections connected therewith. Defendants' PX 25 does not employ such a linkage and therefore does not come within the terms of Claim 8.

83. Plaintiffs failed to prove that the defendants' structures were equivalents. Plaintiffs' witnesses admitted defendants' structures were different and operated in a different way.

84. The remaining claims in suit are dependent claims, namely, Claim 7 which depends on Claim 1, and Claim 9 which depends on Claim 6. If the main claims are not infringed, the dependent claims are not infringed.

History of Prosecution in the Patent Office—Fraud and Unclean Hands.

85. Prior to filing the application which led to the patent in suit, Wilson had a patentability search made. The person making the search was requested to run a search for folding

tables with individual seats and it was indicated to him that Wilson already had adequate prior art involving tables with benches. The search, which was reported to Wilson in March, 1960, disclosed a number of patents which the searcher regarded as pertinent, including Thixton, No.1,586,487; Weinbaum, No. 2,019,374; Bennett, No. 2,502,502; Loibl, No. 2,613,728; and Wilson, No. 2,721,778.

86. On October 17, 1960, Kermit H. Wilson filed the original application Ser. No. 63042, which led to the patent in suit. On March 1, 1961, all claims were rejected as not being patentable over Mackintosh No. 2,788,059, in view of Matthews No. 1,143,416 and Wilson No. 2,831,741. References made of record were of Pacquette No. 2,039,378, Mugler No. 2,650,146, and Nelson No. 2,764,460.

87. In response filed August 30, 1961, Wilson cancelled Claims 6, 7 and 8 of the patent. Claims 1, 2, 5, 9 and 10 were amended. New Claims 11 and 12 were added which became Claims 8 and 9 of the patent in suit. Amended Claim 1 became Claim 1 of the patent in suit, original Claim 9 became Claim 6 of the patent in suit, original Claim 10 became Claim 7 of the patent in suit.

88. The Mackintosh Patent No. 2,788,059, as stated above in more detail, recited a centerfold table with benches with legs maintaining a parallel-vertical relationship during folding and unfolding. The applicant argued, in distinguishing this reference, that Mackintosh failed to teach the use of individual seats which was "not shown or suggested by either Mackintosh or any of the other references of record.

89. The use of individual seat on folding table-seat structure was shown in Weinbaum and Loibl, which were not cited by the Examiner but which were known to Wilson.

90. In August, 1961, more than one year after the tables disclosed in '705 were in public use, plaintiff Wilson added Claims 11 and 12 of the application, claims which became 8 and 9 of the patent in suit.

91. Applicant, in arguing allowability, stated that Mackintosh had benches rather than individual seats and "carried one each by a different one of the legs and overlying in part their respective ones of the intermediate connecting leg portions." (File Wrapper, p. 29.) Applicant further argued that the ease of access due to the bending of the intermediate leg portion was not shown by the references of record. However, included in the prior art patents which were not cited to the Examiner but of which applicant was aware, were prior art patents, including Loibl, which showed a folding table with individual seats, with seats offset from the intermediate leg portion to allow ease of access.

92. In arguing allowability, applicant stated (File Wrapper, p. 30), "In view of the fact that applicant is the first to provide a folding table structure having a pair of hinged top sections and a plurality of leg structures for each of said top sections, together with a plurality of horizontally disposed individual seat elements mounted one each of a different one of the lower leg sections, it is believed that he is clearly entitled to a claim of the breadth of claim 11." The Loibl patent, of which the applicant was aware, had all of the elements alleged to be the applicant's novel contribution.

93. In arguing allowability of Claim 1, after noting that the Examiner's rejection was based "on the grounds that it would be an obvious modification to substitute the individual seats of Matthews for the benches of Mackintosh," applicant stated: "While the seat elements of Matthews do swing inwardly with respect to the table, about the axes of hinge con-

nections 16, there is no showing or suggestion in Matthews of a folding table wherein the leg structures upon which the seat elements are mounted support the table. It is noted that in Matthews, the seat supporting legs are secured to a rigid table supporting pedestal." (File Wrapper, p. 27.)

94. At the time applicant made this argument distinguishing Matthews, which involved a pedestal-type library table with stools on tubular mountings extending outward from the pedestal, applicant was aware of prior art which showed a folding table "wherein the leg structures upon which the seat elements are mounted support the table," including the Weinbaum patent, which was not cited to the Examiner.

95. In arguing allowability of Claim 2 (later stated to be related to Claim 11—Claim 8 in suit), applicant distinguished Wilson, which was "a centerfold table with control arms and linkage connecting the intermediate part of the control arms to the outer legs to maintain them in parallel relationship during folding and unfolding," elements which were also found in the applicant's structure, and applicant asserted, "While Wilson of record does show a pair of control arms, and rigid links are shown as being connected to the outer leg structures, the inner ends of the top sections are supported by a common leg structure, and the earlier Wilson structure of record is devoid of the rigid links connecting inner and outer leg structures in the manner defined in Claim 2. Moreover, none of the references of record, including Mackintosh, show or even suggest this specific arrangement of rigid links and control arms in combination with individual seat elements on leg structures as defined in Claim 2." (File Wrapper, p. 28.)

96. Midwest's accused structure has a center leg structure common to both table tops.

97. The Patent Examiners who handled the prosecution of the '705 patent in suit are F. Zugel, J. McCall, and Primary Examiner G. L. Brehm.

98. During the prosecution of the '705 patent in suit, two separate searches of the prior art were made by the Patent Examiners, namely, on February 14, 1961, Examiner Zugel searched Class 155 subclasses 124B, 124C, 124S, 123B, 123C and Class 311 subclasses 89, 89.1, 92, and 16.5; and on January 9, 1962, Examiner McCall searched Class 297 subclasses 157 and 159 and Class 248 subclass 373.

99. At the time of the prosecution of the '705 patent in suit, prior art patent Loibl 2,613,728 was classified in Class 155 subclass 124B.

100. During the prosecution of the '705 patent in suit prior art patent Wilson 2,771,937 was classified in Class 297 subclass 159.

101. On June 8, 1962, during the same period that the '705 patent in suit was pending, Examiner McCall cited Wilson 2,771,937 as a reference against another pending table application.

102. Two of the Patent Examiners that handled the prosecution of the '705 patent in suit, namely, Zugel and Brehm, also were involved in the prosecution of U.S. Taylor 2,908,322 cited by defendants. In the Taylor case the Loibl patent 2,613,728 was cited.

103. Two of the Examiners that handled the prosecution of the '705 patent in suit, namely, McCall and Brehm, also handled the prosecution of Wilson patent 3,075,809.

104. Patent Examiner McCall knew of U.S. patent Wilson 3,055,705, the patent in suit, at the time he handled the prosecution of U.S. patent 3,075,809.

105. Patent Examiner McCall made a search of the prior art with respect to the Wilson '809 patent on January 8, 1962, and made a search of the prior art with respect to the Wilson '705 patent, the patent in suit, one day later on January 9, 1962.

106. Patent Examiner McCall, who handled the prosecution of the '705 patent in suit, also handled the prosecution of Wilson patent 3,109,678.

107. The Patent Examiners who processed the patent in suit must have been thoroughly familiar with the art, and it has not been shown by a preponderance of the evidence that they were deceived by any act or omission of the applicant.

CONCLUSIONS OF LAW

1. The Court has jurisdiction of the parties and the subject matter. Venue is proper.

2. Claims 1, 6, 7, 8 and 9 of the patent in suit, U.S. Patent No. 3,055,705, are invalid for want of invention and obviousness.

3. Said claims are also invalid because they seem to claim a function or result which is not patentable.

4. Claims 6, 8 and 9 are invalid because they are not supported by specific disclosures or descriptions in the specifications and in fact do not relate to the alleged invention of the patent.

5. The claims in issue are also invalid for failure to disclose as an element of the claimed combination a torsion bar or equivalent energy storing element, which element is necessary to make the claimed structure operable in the manner and for the purpose intended.

6. Defendants' manufacture and sale of accused Models 4012 and 4016 do not infringe claims 1, 6, 7, 8 and 9, assuming said claims were valid.

7. Defendants' manufacture and sale of accused Model 4008 does not infringe claims 6, 8 and 9, assuming said claims were valid.

8. Defendants' affirmative defenses of fraud and unclean hands have not been proved.

9. Defendants shall recover their costs but not attorneys' fees.

Enter:
PHILIP W. TONE
Judge

Dated: October 10, 1972.

Name of Presiding Judge, Honorable Philip W. Tone
Date October 30, 1972

ORDER

Based upon the memorandum of decision and the Findings of Fact and Conclusions of Law entered by the Court on October 10, 1972, It is ordered, the complaint herein is dismissed with prejudice, and defendants shall recover their taxable costs.

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No. 73-1202

In the
Supreme Court of the United States
OCTOBER TERM, 1973

KERMIT H. WILSON and
SICO INCORPORATED,
Petitioners,

vs.

MIDWEST FOLDING PRODUCTS
MANUFACTURING CORP.

and

MIDWEST FOLDING PRODUCTS
SALES CORPORATION,
Respondents.

RESPONSE TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

JOHN C. BREZINA
DAVID D. KAUFMAN
29 South LaSalle Street
Chicago, Illinois 60603

The Scheffer Press, Inc.—(312) 263-6850

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I. NO CASE OR CONTROVERSY EXISTS BECAUSE THE DECISIONS BELOW OF INVALIDITY AND NON-INFRINGEMENT ARE SUPPORTED BY INDEPENDENT GROUNDS NOT PRESENTED IN THE PETITION.

A. THE "ISSUES" BEFORE THIS COURT.

Petitioners purported to assert three "Questions Presented": the first relating to 35 USC §103, *Graham* v. *John*

Deere, 383 U.S. 1 (1966) and "obviousness"; the second relating to infringement and interpretation of the claims; and the third asking what disposition should be made on appellate review if error is found as to the first two questions.

No other questions are before this court (Supreme Court Rule 23(c)).

Examining the "questions presented", it will be seen that the third question clearly states no reviewable legal issue but only asks rhetorically what relief should be granted, if error is found. Furthermore, it is not supported by facts in the "Statement of the Case" as required by Rules 23(e) and (h).

Regarding the second "question presented", there is absolutely no discussion or factual support therefor in the "Statement of the Case". Thus, it is apparent that only the first question is before this Court.

B. THE JUDGMENT OF THE DISTRICT COURT, AFFIRMED BY THE APPELLATE COURT, FOUND THE CLAIMS IN SUIT INVALID ON A NUMBER OF GROUNDS.

At the outset, it is important to correct a misimpression created by the loose presentation of the petitioners. The lower courts did not hold the *patent* or the *invention* invalid for "obviousness" under 35 USC §103. Instead, they found five of the nine *claims* of the patent invalid for a variety of reasons, all of which are fully supported by the record.

Referring to the Findings of Fact (F) and Conclusions of Law (C), it will be seen that the District Court found:

1. All the claims in suit, Claims 1, 6, 7, 8 and 9 are invalid for indefiniteness (35 USC §112) for failure to

recite an essential element necessary to make the claimed structures operable (F66, C5).

2. Claims 6, 8 and 9 are invalid for indefiniteness (35 USC §112) because they recite inventions other than that described and contemplated in the specification (F 61, 63, 64, 69, 70, 82, C4).

3. Claim 6 is directly anticipated (35 USC §102) by prior art patents not considered by the Patent Office (F60, 62).

In addition to the listed grounds, Claims 1, 6, 7, 8 and 9 were held invalid for obviousness under 35 USC §103, (F42-60, C2), the sole "question presented" to this Court by the petitioners.

Furthermore, the District Court found that the accused structure does not infringe the patent claims in suit (C6, 7). It is worthy of note that this determination was based upon meticulous comparison of structures, methods of operation, and claim language (F9-16, 32-41, 71-84). It is likewise noteworthy that each claim in suit contained at least one "means" limitation and that the District Court properly construed the claim language in accordance with the mandate of 35 USC §112. Obviously, such determination bears no relationship whatever with 35 USC §103 or *Graham* v. *Deere* standards as petitioners apparently are contending.

In view of the foregoing, it is apparent that, even were this Court to accept every proper "question presented" by petitioners, the claims in suit still would be invalid and not infringed if valid. The Petition thus presents no "case or controversy" for this Court to decide. *California* v. *San Pablo & Co. Railroad* 149 US 308, 314 (1893).

II. THE DISTRICT COURT CAREFULLY FOLLOWED THE GRAHAM v. DEERE STANDARDS AND HAD AMPLE FACTUAL SUPPORTS FOR ITS FINDINGS AND CONCLUSIONS OF OBVIOUSNESS IN THE PRIOR ART AND TESTIMONY OF WITNESSES.

Petitioners' entire argument as to the alleged erroneous application of *Graham* v. *Deere* is based on their unsupported statement that defendants failed to introduce any evidence of the level of ordinary skill in the art and the difference between the prior art and the claims at issue. Nothing could be further from the facts.

The record evidence comprises the prior art itself, including uncited prior art which was found to *fully anticipate* claim 6 under §102 (F60, 62) plus testimony in court by at least three persons skilled in the art. Indeed, the evidence proved that some of the pertinent uncited prior art was known to petitioners and previously considered pertinent by their patent attorney-searcher.

The patentee, Wilson, testified in depositions and at the trial as did petitioners' chief engineer, Bue, and their "expert" Clark. Bue was an experienced engineer in the field at the time of the alleged invention, and the patentee Wilson and his "expert" Clark obviously must be considered persons skilled in the art at the time the invention was made. Wilson and Bue were cross-examined extensively as to the background of the development of the device shown in the patent in suit. Wilson, particularly, testified as to the prior art tables with seats, that there were similar folding table units with benches, and that *after customers gave him the idea* of replacing the benches with individual seats, he simply "cut slots in these benches, you might say".

All of these witnesses testified about the pertinent prior art patents and the alleged differences between those structures and the invention in suit. Petitioners' patent expert, attorney Sell, likewise testified in open court and their patent agent Ringswood testified by deposition regarding the prior art.

Petitioners' no-evidence assertion conveniently ignores the fact that the testimony of their own witnesses is evidence in the case even when it supports the defendants' position. For example, we know of no better evidence of non-infringement than the cross-examination and testimony of petitioners' own witnesses, Wilson, Bue and Clark, that the patented and accused devices were different in structure and operated in a different way.

Additionally, respondents' witness, Haunost, testified about his independent development of the accused structure. He is a practical engineer of many years experience, having designed folding bench tables for defendant as early as 1957. He testified, upon direct examination, vigorous cross-examination by petitioners' counsel, and extensive questioning by the District Court itself, that he independently developed the exhibit DX55 solely from the teachings of the Mackintosh patent.

Clearly, the mass of evidence alluded to provides more than ample record support for the District Court's reference in its Memorandum opinion to "examination of the prior art" and "listening to the witnesses skilled in the art" (A 4, 5).

CONCLUSION

The judgment of the District Court, affirmed by the Court of Appeals, is correct in all respects, and petitioners have not presented a proper case or controversy for decision by this Court. The Petition for Writ should be denied.

Respectfully submitted,

JOHN C. BREZINA
DAVID D. KAUFMAN
29 South LaSalle Street
Chicago, Illinois 60603